



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,096	11/17/2003	Shoko Yoshida	117791	2226
25944	7590	11/30/2006		
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			EXAMINER BORISSOV, IGOR N	
			ART UNIT 3628	PAPER NUMBER
DATE MAILED: 11/30/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/713,096

Applicant(s)

YOSHIDA ET AL.

Examiner

Igor Borissov

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 5,6 and 12-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 7-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Applicant's election with traverse of Claims 1-40 filed on 8/31/2005 is acknowledged. The traversal is on the ground(s) that undue searching should not be required. This is not found persuasive because Examiner believes that the restriction is proper since the subcombinations are distinct from each other and are shown to be separately usable.

Specifically, Inventions A, B, C, D and E are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention B has utility separate from that of inventions A and C-E, such as authenticating an identity of customer payment authorization; invention C has utility separate from that of inventions A, B, D and E, such as conducting a survey regarding a customer service; invention D has utility separate from that of inventions A-C and E, such as distributing a promotion to a customer; and invention E has utility separate from that of inventions A-D, such as offering an extended warranty for a product. See MPEP § 806.05(d).

Examiner maintains that it would be a serious burden to search all inventions given their separate status in the art as noted above.

The requirement is still deemed proper and is therefore made FINAL. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claims 5, 6, and 12-40 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. It is noted that Applicant timely traversed the restriction (election) requirement.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claims 7 and 8 recites the following limitation in the last line: "...and the rest is performed", which is confusing. It is not clear what exactly is considered to be performed. Furthermore, claim 7, line 18, include the word "performs", which is confusing.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 7 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 7 recites a series of steps which do not include a pre- or post-computer activity but merely perform a series of steps of receiving and updating data such as registered information, and are directed to non-statutory subject matter. A process is statutory if it requires physical acts to be performed outside of the computer

independent of and following the steps performed by a programmed computer, where those acts involve the manipulation of tangible physical objects and result in the object having a different physical attribute or structure (*Diamond v. Diehr*, 450 U.S. at 187, 209 USPQ at 8). Further, the claims merely manipulate an abstract idea (receiving and updating data) or perform a purely mathematical algorithm without limitation to any practical application. A process which merely manipulates an abstract idea or performs a purely mathematical algorithm is non-statutory despite the fact that it might have some inherent usefulness (*Sakar*, 558 F.2d at 1335, 200 USPQ at 139).

Furthermore, in determining whether the claimed subject matter is statutory under 35 U.S.C. 101, a practical application test should be conducted to determine whether a "useful, concrete and tangible result" is accomplished. See *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1359-60, 50 USPQ2d 1447, 1452-53 (Fed. Cir. 1999); *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1600 (Fed. Cir. 1998). A claim as a whole does not provide any indication about usefulness of the recited method.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 2, 4, and 7-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meyer et al. (US 6,915,271).**

Meyer et al. (Meyer) teaches a computer-implemented method for customer registration, comprising:

Claim 1,

a step to receive customer information inclusive of information related to a customer that purchases goods of services (information related to a particular credit card which the customer uses); a step to store the received customer information onto a storage device and to perform the customer registration as a purchaser of merchandise (billing statement); and a step to transmit information advising to perform a membership registration different from the customer registration to the customer, after completing a customer registration (ask the consumer to sign up) (C. 30, L. 23-53)

While Meyer does not explicitly teach that said information related to a customer that purchases goods of services includes information inclusive of information about a customer that purchases merchandise and information about merchandise that the customer purchases sent from the customer, Meyer teaching of holding a particular credit card suggest obtaining and storing information regarding merchandises bought by using said particular credit card.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Meyer to include that said information related to a customer that purchases goods of services includes information inclusive of information about a customer that purchases merchandise and information about merchandise that the customer purchases sent from the customer, because it would advantageously allow to implement the well-known and widely used financial mechanism, thereby providing convenience to the customer.

Claims 2 and 4, same reasoning as applied to claim 1.

Claim 7,

a step to receive customer information inclusive of information related to a customer that purchases goods of services (information related to a particular credit card which the customer uses); a step to store the received customer information onto a storage device; a step to perform a customer registration as a purchaser of

merchandise (billing statement); a step to receive membership information for a membership registration different from the received customer information; a step to store the received membership information onto a storage device and perform a membership registration different from the registered customer registration (ask the consumer to sign up); wherein receiving the customer registration information, as well as validation of prior records indicates a step to update registered information of either of the registrations with new information with regard to information in common with the customer information and the membership information when either of the customer registration or the membership registration has been already performed and the rest is performed (C. 30, L. 23-53).

While Meyer does not explicitly teach that said information related to a customer that purchases goods of services includes information inclusive of information about a customer that purchases merchandise and information about merchandise that the customer purchases sent from the customer, Meyer teaching of holding a particular credit card suggest obtaining and storing information regarding merchandises bought by using said particular credit card.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Meyer to include that said information related to a customer that purchases goods of services includes information inclusive of information about a customer that purchases merchandise and information about merchandise that the customer purchases sent from the customer, because it would advantageously allow to implement the well-known and widely used financial mechanism, thereby providing convenience to the customer.

Claims 9-11, same reasoning as applied to claim 7.

Claim 8,

a step to receive customer information inclusive of information related to a customer that purchases goods of services (information related to a particular credit

card which the customer uses); a step to store the received customer information onto a storage device; a step to perform a customer registration as a purchaser of merchandise (billing statement); a step to perform a membership registration different from the registered customer registration (offering the consumer to sign up via a network indicates conducting prior steps of: receiving membership information for a membership registration different from the received customer information; and storing the received membership information onto a storage device); and a step to provide to a registration performer information about a registered item out of common items in customer information and membership information when either of the customer registration or the membership registration has been already performed and the rest is performed (C. 30, L. 23-53).

While Meyer does not explicitly teach that said information related to a customer that purchases goods of services includes information inclusive of information about a customer that purchases merchandise and information about merchandise that the customer purchases sent from the customer, Meyer teaching of holding a particular credit card suggest obtaining and storing information regarding merchandises bought by using said particular credit card.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Meyer to include that said information related to a customer that purchases goods of services includes information inclusive of information about a customer that purchases merchandise and information about merchandise that the customer purchases sent from the customer, because it would advantageously allow to implement the well-known and widely used financial mechanism, thereby providing convenience to the customer.



**Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Meyer et al. in view of Keen et al. (US 5,774,882).**

Claim 3. Meyer teaches all the limitations of claim 3, except specifically teaching that the customer information includes information about whether a customer is a corporate or an individual, and only when the customer is an individual, information advising the membership registration is transmitted.

Keen et al. (Keen) teaches a method for customer registration, including a step of obtaining information whether the applicant is a corporate one or an individual to be processed differently (C. 3, L. 34-57).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Meyer to include that the customer information includes information about whether a customer is a corporate or an individual, and only when the customer is an individual, information advising the membership registration is transmitted, as suggested by Keen, because it would advantageously allow to tailor said method to a particular type of consumers, thereby increase effectiveness and potentially generate more revenue.

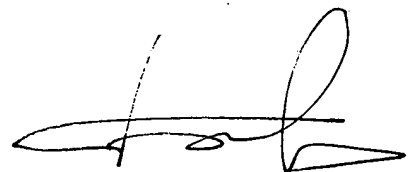
***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

IB  
11/16/2006

A handwritten signature in black ink, appearing to read 'Igor N. Borissov', with a stylized, flowing script.

IGOR N. BORISSOV  
PRIMARY EXAMINER